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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/656,718

09/08/2003

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8257

7590  
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04/04/2008

EXAMINER

TON, ANABEL

ART UNIT

PAPER NUMBER

2875

MAIL DATE

DELIVERY MODE

04/04/2008

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/656,718	<b>Applicant(s)</b> MILLER ET AL.	
	<b>Examiner</b> ANABEL M. TON	<b>Art Unit</b> 2875	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 31 December 2007.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1 is/are rejected.
- 7) ☒ Claim(s) 2-10 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 103***

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claim 1 is rejected under 35 U.S.C. 103(a) as being unpatentable over Fuke et al (6,011,929) and further in view of Szymanek (4,891,737).

3. The recitation "a track light" has not been given patentable weight because the recitation occurs in the preamble. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951).

4. Fuke et al discloses a reflector (2) extending along the length of said tube and having angularly disposed portions proximally joined at an apex on an optical axis of symmetry, said angularly disposed portions having distal edges(end portions of 2); a first and second light controlling member fixed to the edges of the reflector one light source positionable along the length of the tube between the reflector and first light controlling member, emitting light through the first and second light controlling member generally perpendicular to the length of the tube. Fuke does not specifically recite the first and

second light controlling members being a diffuser and a lens. Szymanek discloses a light controlling system for a light fixture, having a lens body 11 extending between the diffuser and a potential light source, the lens extending between the distal ends of the diffuser. It would have been obvious to one of ordinary skill in the art at the time the invention was made for the first and second light controlling members of Fuke to include a lens and diffuser, respectively, for the advantages as taught by Szymanek.

### ***Allowable Subject Matter***

5. Claims 2-10 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. The subject matter of claims 2 and 3 is not taught by the prior art cited of record. Claims 4-10 are allowable because of their dependency.

### ***Response to Arguments***

6. Applicant's arguments filed 12/31/07 have been fully considered but they are not persuasive. To begin applicant argues that the term "track light" should be given patentable weight since "a preamble comprising a general description of all the elements or steps in claimed invention which are conventional or known", Although this may be the definition of a preamble, the examiner asserts that the term "track light" which applicant is depending on to define the entire invention, as stated above. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the

claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951). In this case, the term "track light" is not considered to be an entire and precise description of the invention but an intended use, in particular since applicant has not claimed features so as to facilitate the instant invention in a track light application. With regards to applicant's arguments regarding the reference of Szymanek and in particular that Szymanek does is not a track light and does not disclose the features as applicant describes on page 3 of the response, applicant is reminded that Szymanek is being used as a teaching reference to show a light controlling system with a lens and diffuser, the lens extending between the diffuser and is clearly not being used as the primary reference, therefore not teaching the features as argued by applicant on page 3 since Fuke is being used as the primary reference. In response to applicant's argument that Szymanek is nonanalogous art, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). Applicant argues that the reference of Fuke does not teach a tubular shape, does not have light sources positioned along the length of its body, but only has one "bar like light source" and does not have an angular reflector extending along the length of the tube. To begin, applicant only requires "one or more light sources" which is satisfied by Fuke since Fuke discloses one light source; with

regards to Fuke having a tubular shape, the reflecting portion discloses a concave shape that is broadly interpreted as tubular, furthermore, applicant has not disclosed in the claim how the tubular shape encompasses the lens and reflector or how the lens and the reflector comprise a tubular shape or how the tracklight in the form of an elongated tube structurally relates to reflector, diffuser, lens and light source therefore Fuke is considered to satisfy this limitation as well. For these reasons the above stated rejection remains and is made final.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to ANABEL M. TON whose telephone number is (571)272-2382. The examiner can normally be reached on 08:00-16:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sandra O'Shea can be reached on (571) 272-2378. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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